

REMARKS / DISCUSSION OF ISSUES

Claims 1-16 are presented for consideration.

Claims are amended for non-statutory reasons, such as to delete a reference character inadvertently included in the claim. No new matter is added.

Improper Restriction/Election Requirement—Request for Examination

Claims 10-14 are allegedly directed to an independent or distinct invention from that which was initially claimed. The Examiner then relegates these claims as withdrawn for being constructively non-elected. Applicants respectfully submit that the restriction of these claims is improper and should be withdrawn. Moreover, substantive examination in a separate Office Action is requested.

At the outset, Applicants note that there are two requirements for a proper requirement of restriction.

The first requirement is:

“The particular reasons relied on by the examiner for holding that the inventions as claimed are either independent or distinct should be concisely stated. A mere statement of conclusion is inadequate. The reasons upon which the conclusion is based should be given.”

The Examiner states that the that the ‘weighing device adapted to detect a distribution of pressures exerted by at least one foot of the person on a surface’ raises a new issue which would require further search and consideration. However, no clear reasoning is provided as to what new issue is raised and why a further search and consideration is required. Applicants request the disclosure of the new issue and what areas of the manual of classification must be searched to properly examine the newly added claims.

The second requirement is that the Examiner establishes that there would

be a serious burden on the Examiner if restriction is not required. Under MPEP § 808 the Examiner must show one of the following: (A) Separate classification thereof; (B) A separate status in the art when they are classifiable together; (C) A different field of search.

Respectfully, the Examiner has not shown any of these criteria, but rather merely alleges that further searching is required. To wit, no basis in support of the further search is provided.

For at least the reasons set forth above, Applicants respectfully submit that a proper requirement for restriction has not been established and thus should be withdrawn. If the Examiner maintains that the claims are properly restricted, a proper showing under the criteria set forth in the MPEP is respectfully requested in a further office action. If the restriction is withdrawn, full and complete examination of claims 10-14 is respectfully requested, with communication in a subsequent office action.

Claim Objection

The objection to claim 15 has been considered and is respectfully traversed. The Office Action alleges that the claim is a 'duplicate of claim 8.' The Office Action asserts that when claims are duplicates or so close in content that they cover the same thing, it is proper after allowing one claim to object to the other.

At the outset, Applicants note that neither claim 8 nor claim 15 is allowed, rendering this objection premature. That said, Applicants demur that the claims are 'the same.'

Claim 8 is drawn to "A method of identifying a person, wherein said method comprises the steps of..."

Claim 15 is drawn to "A method of identifying a person, the method comprising:..."

While somewhat subtle in difference, the preambles of claims 8 and 15 have different meanings in the interpretation of the claims, and thus the claims are not the same in content as the Office Action alleges.

Rejections under 35 U.S.C. § 102

Claims 1-3, 5, 6 and 8 are rejected under 35 U.S.C. § 102(b) as being anticipated by *Speeter* (U.S. Patent 5,479,528). For at least the reasons set forth herein, Applicants respectfully submit that this rejection is improper and should be withdrawn. Applicants note that the basis of rejection is in *ipsis verbis* that of the rejection dated March, 2007. Thus, Applicants reiterate their traversal provided in the response under Rule 111. Notably, the arguments provided in the Rule 111 are not repeated herein in the interest of brevity. Nonetheless, the position established thereby is maintained.

Again, Applicants rely at least on the following standards with regard to proper rejections under 35 U.S.C. § 102. Notably, a proper rejection of a claim under 35 U.S.C. § 102 requires that a single prior art reference disclose each element of the claim. *See, e.g., W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303, 313 (Fed. Cir. 1983). Anticipation requires that each and every element of the claimed invention be disclosed in a single prior art reference. *See, e.g., In re Paulsen*, 30 F.3d 1475, 31 USPQ2d 1671 (Fed. Cir. 1994); *In re Spada*, 911 F.2d 705, 15 USPQ2d 1655 (Fed. Cir. 1990). Alternatively, anticipation requires that each and every element of the claimed invention be embodied in a single prior art device or practice. *See, e.g., Minnesota Min. & Mfg. Co. v. Johnson & Johnson Orthopaedics, Inc.*, 976 F.2d 1559, 24 USPQ2d 1321 (Fed. Cir. 1992). For anticipation, there must be no difference between the claimed invention and the reference disclosure, as viewed by a person

of ordinary skill in the field of the invention. *See, e.g., Scripps Clinic & Res. Found. v. Genentech, Inc.*, 927 F.2d 1565, 18 USPQ2d 1001 (Fed. Cir. 1991).

In the Response to Arguments, the Examiner states:

10. Applicant's arguments regarding the prior art rejections of claims 1-9 have been fully considered but they are not persuasive.

Applicants argue that "[t]here is no description of the detecting *pressure distributions* and comparing these *pressure distributions* with stored *pressure distributions*" because the reference to Speeter discloses only "piezoresistive and capacitive tactile (touch) arrays" and "[t]hese relate to force calculations on intelligent work surfaces". The arguments are not persuasive. Giving the claims their broadest reasonable interpretation, the Examiner holds the position that all the subject matters recited in claims 1-9 have been taught or suggested or disclosed by the cited prior art references, either individually or in combination (see sections 4 and 6 set forth above in this Office Action for more details). In particular, it is deemed that the "force-image of an individual's handprint or footprint" taught by Speeter is equivalent to the "distribution of pressure, exerted by at least one foot of the person on a surface" as recited in claims 1-9 of the instant application, considering that the "pressure" is simply the force per unit area exerted against a surface by the weight of an object above that surface. The rejections are therefore maintained.

The Examiner deems that a force-image of an individual's handprint or footprint is 'equivalent to' the distribution of pressure exerted by at least one foot of the person on a surface.

By 'deeming' the disclosure of the applied art to *Speeter* is that which's claimed, the Examiner is taking either taking official notice that the teachings of the applied art anticipate that which is claimed; or alleging that the disclosure is inherently the same as that which is claimed. In either case, there is no evidence

provided in support of this position. Respectfully, as stated in MPEP 2144, the taking of official notice is not be appropriate "...without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known. For example, assertions of technical facts in the areas of esoteric technology or specific knowledge of the prior art must always be supported by citation to some reference work recognized as standard in the pertinent art."

Respectfully, the facts at issue are not capable of instant and unquestionable demonstration as being well-known. Applicants traversal of the rejection as recited in the Response under Rule 111 are, in and of themselves, sufficient to call into question demonstrability that the facts are not well-known. Thus, a prior art citation is required. If the taking of Official Notice as to the facts in dispute are based on the purview of the Examiner, an affidavit under 37 C.F.R. §1.104(d)(2) is requested.

Alternatively, and in the event that the basis of this aspect of the rejection is one of inherency, M.P.E.P. § 2112 IV provides that:

*EXAMINER MUST PROVIDE RATIONALE OR EVIDENCE
TENDING TO SHOW INHERENCY*

*The fact that a certain result or characteristic **may** occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. In re Rijckaert, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art); In re Oelrich, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981).*

“To establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.’ ” In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999).

(emphasis added).

Furthermore, a claim rejection must be based on objective evidence of record, and cannot be supported merely on subjective belief and unknown authority. See, e.g., M.P.E.P. § 2144.03; In re Lee, 277 F.3d at 1344-45, 61 USPQ2d at 1434-35 (Fed. Cir. 2002); In re Zerko, 258 F.3d at 1386, 59 USPQ2d at 1697.

No such concrete evidence has been provided by the Examiner here, nor did the Examiner submit an affidavit as required by 37 C.F.R. § 1.104(d)(2) if this proposed motive were based on facts within his personal knowledge (see M.P.E.P. § 2144.03). Applicants respectfully request that such an affidavit be provided if a rejection continues to be made without a citation of any objective evidence. extrinsic evidence in support of this position is requested. If this evidence is based on the personal knowledge of the Examiner, the affidavit under 37 C.F.R. § 1.104(d)(2) is requested.

Rejections under 35 U.S.C. § 103

Applicants have considered the rejection of claims 4,7 and 9 in view of *Speeter* and *Wymore*. While Applicants by no means concede the propriety of the

rejection, Applicants respectfully submit that the rejection is moot and that claims 4, 7 and 9 are patentable over the applied art for at least the same reasons as their respective independent claims.

Conclusion

In view the foregoing, applicant(s) respectfully request(s) that the Examiner withdraw the objection(s) and/or rejection(s) of record, allow all the pending claims, and find the application in condition for allowance.

If necessary, the Commissioner is hereby authorized in this, concurrent, and further replies to charge payment or credit any overpayment to Deposit Account Number 50-0238 for any additional fees, including, but not limited to, the fees under 37 C.F.R. §1.16 or under 37 C.F.R. §1.17.

If any points remain in issue that may best be resolved through a personal or telephonic interview, the Examiner is respectfully requested to contact the undersigned at the telephone number listed below.

Respectfully submitted on behalf of:

Phillips Electronics North America Corp.

A handwritten signature in black ink, appearing to be 'WSF', is written over a horizontal line.

by: William S. Francos (Reg. No. 38,456)

Date: October 1, 2007

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